

REMARKS

Applicant has carefully studied the Office Action of March 12, 2004 and offers the following remarks to accompany the above amendments.

Initially, Applicant amends claim 1 to recite the receiving of the audible listing separately from the step of receiving the audible locality response. The claim is further amended to recite that the locality response identifies a locality, and the locality is a geographic location. Similar amendments have been made to the other independent claims 19, 20, and 26. Claim 1 is further amended to recite the subject matter of claim 5, and claim 5 is amended to recite that the locality response is a reply to a "what city" query. Support for this amendment can be found at page 20, lines 13. No new matter is added.

Applicant further amends the claims to delete reference characters such as "a)" or "ii)" for simplicity. The scope of the claims has not changed via this deletion, and no new matter is added.

Claims 1-35 were rejected under 35 U.S.C. § 103 as being unpatentable over Smith et al. (hereinafter "Smith") in view of Bielby et al. (hereinafter "Bielby"). Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the combination of references must teach or suggest all the claim elements. MPEP § 2143.03. If the Patent Office cannot establish obviousness, then the Applicant is entitled to a patent. Applicant further notes that there are instances when it is improper to combine references. One instance where it is improper to combine references is when the combination makes one of the references unsuited for its intended purpose. MPEP § 2143.01.

Initially, Applicant notes that Smith is designed to connect a caller directly to the entity whose phone number the caller was seeking. This connection is effectuated without reciting the phone number to the caller. One of the purposes of this arrangement is to avoid having the caller use the digits to dial. See Smith, col. 3, line 66-col. 4, line 4. Further, this arrangement is done so that the services listed in the CVD can benefit from increased traffic, and they are billed accordingly for this increased traffic. See Smith, col. 10, lines 13-14. By combining Smith with Bielby, and particularly the portions of Bielby that teach announcing the number corresponding to the audible listing response and the audible locality response, the Patent Office vitiates the purpose of Smith by taking away the direct connection. Since the Patent Office's combination makes Smith unsuited for its intended purpose, the combination is not proper.

Even if the combination is proper, the references do not show the claimed invention. The claim recites an audible listing and a locality response. The Patent Office, in its analysis of Smith, correlates a business type with an audible listing and a callname with the locality response. The Patent Office supports this analysis with a citation to col. 13, lines 10-23. Applicant respectfully disagrees with this interpretation. Specifically, as explained in Smith, col. 12, lines 3-22, a callname is a name like "Domino's" or "Baylor" and the business type is line of business like "Pizza" or "Hospital." Thus, even under a broad, reasonable interpretation of "locality," Smith's callname does not show a locality. Likewise, the business type is not a listing as recited in the claims. However, to clarify Applicant's intended meaning, the independent claims are amended to recite that the locality is a geographic location. As clarified by the current amendments, it is clear that a callname is not the same thing as the recited locality response because the callname is not a geographic location. Neither Smith's callname nor Smith's business type has any relationship to a geographic location as recited in the claims. Since the callname and business type are not related to a geographic location, Smith does not show the claim element. Likewise, the Patent Office has not identified any location within Bielby that cures the deficiencies of Smith. Since the references individually have not been shown to have the claim element, the combination of references does not show the claim element, and the Patent Office has not established obviousness for the independent claims, and the independent claims are patentable.

The dependent claims are patentable at least for the same reasons that the independent claims are patentable.

Some claims deserve special mention. Claim 10 recites "the selecting further comprising sifting to eliminate ones of the plurality of records until there is one record or a common number throughout any remaining records. Claim 33 is similar in relevant part. The Patent Office opines that this element is taught at Smith, col. 16, lines 3-12. Applicant traverses this assertion. While the cited passage of Smith does indicate that the database may be divided into subsets, the separation of the database does not eliminate records until there is only one record or common number as recited in the claim. Specifically, the passage makes it clear that the database subsets includes nationally available CVD subscribers such as international airline companies. Since there is a plurality of international airline companies, and this plurality is in each subset, then the subsets have a plurality of records therein (not a single record as recited in the claims), and the

cited passage does not teach the claim element. Since the cited passage does not teach the claim element, and the Patent Office has pointed to nothing in Bielby which cures the deficiency, the combination of references does not show all the elements of the claim. Since the combination of references does not show all the elements, the Patent Office has not established obviousness, and claims 10 and 33 are allowable.

Claims 11-15 depend from claim 10 and are allowable at least for the same reasons as well as independent reasons outlined below.

Claim 11 recites the "sifting comprises removing all other records in the plurality of records not containing the locality response." The Patent Office opines that Smith teaches this element at col. 16, lines 25-36. Applicant respectfully traverses this assertion. The cited passage describes parsing an "Auto Repair" business type by ANI information. The Patent Office has previously identified Smith's callname as the locality response and the Smith's business type as the listing response. Nowhere in the passage is the callname discussed. To this extent, because the passage does not discuss the callname, the passage does not show how the locality information (the callname) is used to remove all other records not containing the locality response. If the Patent Office shifts its analysis and indicates that the ANI information is the locality information, this interpretation is also improper, since the ANI information is not an audible response as recited in the claims. See Smith col. 4, line 65-col. 5, line 5 and col. 6, lines 10-11. In short, Smith does not teach the element for which it is cited. Likewise, the Patent Office has pointed to nothing in Bielby to cure the deficiency of Smith. Since the references individually have not been shown to teach or suggest each of the recited elements, the combination of references have not been shown to teach or suggest each of the recited elements, and the Patent Office has not established obviousness. Since the Patent Office has not established obviousness, claim 11 is allowable.

Claim 12 recites "removing all other records in the plurality of records not containing the expected number." The Patent Office opines that Smith teaches this element at col. 16, lines 54-55 and col. 15, lines 33-37. Applicant respectfully traverses this assertion. While col. 16, lines 54-55 describe creating useful subsets based on the calling party's own calling history, this is not the removal of all other records as recited the claim. Furthermore, col. 15, lines 33-37 discuss a billing arrangement with the subscribers. Nothing in this passage teaches or suggests removing all other records not containing the expected number as recited in the claim. Likewise, the Patent

Office has pointed to nothing in Bielby to cure the deficiency of Smith. Since the references individually have not been shown to teach or suggest each of the recited elements, the combination of references has not been shown to teach or suggest each of the recited elements, and the Patent Office has not established obviousness. Since the Patent Office has not established obviousness, claim 12 is allowable.

Claims 13-15 depend from claim 12 and are allowable at least for the same reasons that claim 12 is. Claim 13 further recites removing all records not having a toll-free number if one of the certain records contains the toll-free number. The Patent Office opines that Smith teaches this at col. 10, lines 38-43. Applicant respectfully traverses this assertion. While the cited passage does describe 800 numbers (i.e., toll-free numbers), the passage does not indicate that other records are removed if there is a toll-free number in one of the records as recited in the claim. Likewise, the Patent Office has pointed to nothing in Bielby to cure the deficiency of Smith. Since the references individually has not been shown to teach or suggest each of the recited elements, the combination of references have not been shown to teach or suggest each of the recited elements, and the Patent Office has not established obviousness. Since the Patent Office has not established obviousness, claim 13 is allowable.

Claim 14 recites "combine the certain records into one." The Patent Office opines that this element is taught at Smith, col. 16, lines 3-5. This cited passage describes dividing the database into subsets appropriate to the calling party, but makes no mention of combining records into one as recited in the claim. Likewise, the Patent Office has pointed to nothing in Bielby to cure the deficiency of Smith. Since the references individually have not been shown to teach or suggest each of the recited elements, the combination of references has not been shown to teach or suggest each of the recited elements and the Patent Office has not established obviousness. Since the Patent Office has not established obviousness, claim 14 is allowable.

Applicant requests reconsideration of the rejection in light of the amendments and remarks presented herein. The claims are patentable because the combination is improper. Even if the combination is proper, the claims are patentable because the Patent Office has failed to show where the combination of references teaches a locality response wherein the locality is based on a geographic location. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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